



Docket No.: 87361.3320
Customer No. 30734

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Craig CALDWELL

Serial No.: 09/899,894

Filed: July 6, 2001

Confirmation Number: 3616

Art Unit: 1723

Examiner: Matthew O. SAVAGE

For: RETURN SIDE FILTER FOR USE IN A VEHICLE TRANSMISSION

**RESPONSE TO RESTRICTION AND ELECTION OF SPECIES
REQUIREMENT UNDER 35 U.S.C. § 121**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the Office Action dated November 21, 2002, Applicant respectfully requests reconsideration of this application in light of the following remarks. In the Office Action, Examiner required that a restriction to one of the distinct inventions be made and an election of species be made under 35 U.S.C. § 121. Specifically, Examiner requires an election of the invention to be examined from a grouping of the claims as filed. Additionally, Examiner requires an election of a single disclosed species for prosecution on the merits to which that claims shall be restricted if no generic claim is finally held to be allowable.

Applicant respectfully traverses the restriction requirement. However, to be fully responsive to the requirement, Applicant hereby elects Group I, claims 1-24.

Claim 30 is generic to all species. Claims 1-9, 31 and 32 correspond to (i.e. are generic to) species 1 and 4. Claims 10-18, 32 and 33 correspond to species 2. Claims 19-29 and 35 correspond to species other than species 3. Applicant respectfully traverses the election

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The Examiner has further required Applicant to elect a single disclosed species from the following:

Species	Figures
1	1-4 and 6
2	5
3	7-9
4	10

Applicant respectfully traverses both the restriction and election requirement. To be fully response to the requirements, however, Applicant hereby elects Group I, claims 1-29 and species 1. According to the Examiner, claims 1-9 of the elected group are readable on species 1.

A requirement for restriction/election is only proper when a serious burden is placed on the Examiner if the restriction is not required. M.P.E.P. § 803. Examiners must provide reasons and/or examples to support conclusions. *Id.* The Examiner has not shown that it would be a serious burden to prosecute all the claims, as well as the species, of the application together. In fact, the Examiner has nowhere presented any reasons that the examination of the claims and/or the species would be a serious burden. Accordingly, Applicants respectfully submit that it would not be a serious burden to simultaneously examine all the claims and species presented and request that the restriction and election requirements be withdrawn.

If the Examiner chooses to maintain the election requirement, however, Applicant expects the Office, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to the patentability thereof, i.e. extending the search to a reasonable number of non-elected species, as is the duty according to M.P.E.P. § 803 and 35 U.S.C. §121.

The Examiner is invited to call the undersigned attorney at 202-861-1555 in an effort to resolve any matter still outstanding before issuing another action.

In the event this paper is not timely received or a further extension is required, Applicant petitions for an appropriate extension of time. Any additional fees may be charged to or overpayment credited to Deposit Account No. 50-2036.

Respectfully submitted,

BAKER & HOSTETLER LLP



William W. Lewis III
Registration No. 48,742

Date: Dec. 13, 2002
BAKER & HOSTETLER LLP
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
Tel. 202 861 1500
Fax. 202 861 1783

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